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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/849,637

05/04/2001

Dov Malonek

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09/17/2004

REED SMITH, LLP

ATTN: PATENT RECORDS DEPARTMENT
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NEW YORK, NY 10022-7650

EXAMINER

EVANISKO, GEORGE ROBERT

ART UNIT

PAPER NUMBER

3762

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/849,637

Applicant(s)

MALONEK ET AL.

Examiner

George R Evanisko

Art Unit

3762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 August 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): 112 second paragraph rejections.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 5-32,35-45 and 62-67.

Claim(s) withdrawn from consideration: 33,46-48 and 50-61.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

George R Evanisko
Primary Examiner
Art Unit: 3762

Continuation of 2. NOTE: the deletion of "wherein...may comprise a unitary electrode" and "or comprising a unitary electrode" and insertion of "modification in the activity...tissue", "is adapted to withstand chronic..delivery", and "having the necessary magnitude...modification" in claim 62 would require further search and consideration.

Continuation of 5. does NOT place the application in condition for allowance because: the arguments are directed to the new issues that will require further consideration and search. In addition, the argument that the electrode is designed and optimized to supply therapeutic signals having energy in a non-excitatory electric field range and is therefore new and inventive is not persuasive. The size of the electric field being delivered (or sensed) has NOT been claimed, only that the electrodes are capable of delivering this field. The field/electrode could be numerous sizes for a human heart, whale heart, a mouse heart, etc. Also, different tissues and different tissue sizes have different non-excitatory thresholds. In addition, any electrode that delivers a pacing pulse or defibrillation pulse is also capable of delivering a pulse that is smaller than a pacing/defibrillation pulse (a "non-excitatory electric field") since nothing will prevent the electrode from delivering a smaller pulse. The argument that a great deal of innovative skill is necessary to balance and optimize the electrodes is not persuasive since the factors, elements, and skill to optimize the electrodes have NOT been claimed. The argument that the size of the electrodes influences the final performance is not persuasive since the size of the electrodes has not been claimed. In addition, the claiming of the size of the electrodes would most likely be found in the prior art since the size of the non-excitatory field or the particular tissue being stimulated has not been defined. Different tissue and different tissue sizes have different thresholds for non-excitatory fields. The argument that the electrodes of the invention are designed to be chronically implanted is not persuasive since this limitation has not been claimed.